

REMARKS

The paper is in response to the Office Action mailed September 23, 2010 ("the Office Action"). The foregoing amendment amends claims 1 and 13. Claims 1-9 and 12-36 remain pending, of which claims 1, 13, 22, 29, and 32 are independent. Applicants respectfully request reconsideration of the application in view of the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Finality Precluded

If the next office action rejects any of the pending claims using a new ground of rejection, the next office action must be nonfinal because the current Office Action fails to establish a *prima facie* case that the pending claims are obvious over the cited references. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, except

where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the present case, if the next office action rejects any of the pending claims using a new ground of rejection, such a rejection would not be necessitated by this response because none of the rejected claims was amended in order to distinguish over the cited references, as explained in the following remarks. Moreover, this new rejection would not have been based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) because no information disclosure was filed and/or none was filed with the fee. Accordingly, under MPEP §706.07(a), the next Office Action must be non-final if it rejects any of the pending claims using a new ground of rejection.

Rejection under 35 U.S.C §103(a)

The Office action rejects claims 1-9 and 12 under 35 U.S.C §103(a) over *Aronson et al.* (U.S. Patent Publication No. 2003/0128411) in view of *Walmsley et al.* (U.S. Patent Publication No. 2003/0172268) and rejects claims 13-36 under 35 U.S.C §103(a) over *Aronson et al.* in view of *Walmsley et al.* as applied to claims 1-9 and 12, in further view of *Liu et al.* (U.S. Patent Publication No. 2004/0249817).

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Finally, MPEP 2141.III notes that:

The key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious*. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on

obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at ___, 82 USPQ2d at 1396.

(Emphases added.)

The pending claims are generally directed to authentication of a transceiver with a host to which the transceiver is coupled. For example, claim 1 recites a transceiver comprising “a controller configured to encrypt a string and supply the encrypted string to [a] host...to authenticate the transceiver.” Each of independent claims 13, 22, 29, and 32, although of different scope than claim 1, recites similar limitations. In contrast, the prior art, whether considered individually or in combination, fails to teach or suggest the foregoing limitations.

The Examiner asserts *Aronson* describes a transceiver, but concedes *Aronson* does not expressly disclose “a controller configured to encrypt a string and supply the encrypted string to [a] host...to authenticate the transceiver.” See *Office Action* at 5. The Examiner relies on *Walmsley* as providing this necessary disclosure. Applicants respectfully disagree.

Walmsley is directed to authentication of a “consumable,” not a transceiver. “Consumables,” as defined by *Walmsley*, include items such as “toner cartridges” for printers. See *Walmsley* at ¶ 3. Nothing in *Walmsley* suggests use of its authentication techniques to authenticate a transceiver. For example, *Walmsley* notes that authentication of consumables is needed to “stop home refill operations” (see *id.* at ¶ 3), but transceivers, unlike toner cartridges, are not capable of being refilled with ink or the like. Moreover, it is only in Applicants’ own disclosure that a suggestion to authenticate transceivers is found.

Applicants note that “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” See *MPPEP* 2142 (emphasis added). *MPPEP* 2142 further explains that to avoid hindsight the Examiner must “put aside” knowledge of Applicants’ disclosure when determining obviousness. As shown above, the Examiner appears instead to have concluded the combination of prior art references would have been obvious for reasons found only in Applicants’ disclosure. Therefore, the Examiner has improperly resorted to hindsight analysis in the conclusion of obviousness.

In light of the foregoing, Applicants respectfully submit that no prima facie case of obviousness has been established with respect to claims 1, 13, 22, 29, and 32. Applicants therefore request withdrawal of the rejection of claims 1, 13, 22, 29, and 32, and their corresponding dependent claims.

Claim 13 is submitted to be allowable over the cited art for additional reasons, as well. Claim 13 recites a network system comprising a transceiver, the transceiver comprising a controller, "wherein the controller is configured to encrypt [a] string using a host-selectable one of a plurality of transceiver private encryption keys stored in the transceiver." (Emphasis added.) The prior art, whether considered individually or together in combination, does not teach or suggest the foregoing limitation.

For example, the Examiner concedes the *Walmsley-Aronson* combination does not disclose a controller configured to encrypt a string using a "host-selectable one of a plurality of transceiver private encryption keys stored in the transceiver," as claimed. See *Office Action* at 8. The Examiner relies on a repository of public keys purportedly taught by *Liu* as providing this necessary disclosure. See *id.* However, a repository of public keys does not constitute "a plurality of transceiver private encryption keys stored in [a] transceiver," as claimed. (Emphasis added.) The distinction between *Liu's* public key repository and the claimed invention's "plurality of transceiver private encryption keys" is significant because private keys must be carefully guarded to preserve security, whereas public keys may be shared publicly, as their name implies, without any security risk. Therefore, for this additional reason, Applicants respectfully request withdrawal of the rejection of claim 13.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise

been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 23rd day of December 2010.

Respectfully submitted,

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